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EXAMINER

LAstra, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,551

Applicant(s)

DISTEFANO, THOMAS L.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-21 have been examined. Application 09/589,551 has a filing date 06/07/2000.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Wexler (U.S. 5,960,409).

As per claim 1, Wexler teaches:

A method of assisting a website designer in establishing an arrangement between a first website being designed by the website designer and a second website in order to market the first website at the second website upon the activation of the first website on the Internet, the method comprising:

during design of the first website, receiving information at a user interface indicating a type of an element for marketing that is to be displayed at the second website, and information specifying the second website at which the element is to be displayed (see column 3, lines 35-45);

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saving the information at a first database that is coupled to the user interface (see column 3, lines 23-35);

obtaining the element for marketing of the type indicated (see column 4, lines 10-17); and

causing the display of the element for marketing at the second website when the first website is activated with respect to the Internet, wherein the element for marketing includes at least one of a banner ad concerning the first website and a link to the first website (see column 1, lines 49-60; column 3, lines 35-58; column 4, lines 10-17).

As per claim 2, Wexler teaches:

The method of claim 1, further comprising, prior to receiving the information indicating the type of the element and the information specifying the second website:

receiving at the user interface information concerning at least one of the website designer, a business of the website designer, and the first website (see column 4, lines 27-36);

performing a search of information on a second database having information concerning at least one of a plurality of third party website designers, a plurality of third party businesses and a plurality of third party websites (see column 4, lines 36-54; column 5, lines 24-44);

identifying from the search at least one third party website to which the first website should be coupled for marketing purposes (see column 5, line 45 – column 6, line 10); and

providing information concerning the at least one third party website at the user interface (see column 6, lines 1-10).

As per claim 3, Wexler teaches:

The method of claim 1, further comprising

during design of the first website, receiving information specifying a plurality of additional third party websites at which it is desirable to have the element displayed (see column 5, lines 24-26);

saving the information at the first database and causing the display of the element for marketing at each of the plurality of additional third party websites when the first website is activated with respect to the Internet (see column 5, lines 24-44).

As per claim 4, Wexler teaches:

The method of claim 1, further comprising:

determining whether a reciprocal site for the display of at least one marketing element of a third party website exists in the first website being designed (see column 5, lines 45-65); and

creating the reciprocal site for the display of the at least one marketing element of the third party website when the reciprocal site does not yet exist in the first website being designed (see column 5, lines 45-65).

As per claim 5, Wexler teaches:

The method of claim 4, further comprising:

when the element for marketing the first website is a banner ad concerning the first website, causing the sequential display at the reciprocal site of the first website of a

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plurality banner ads respectively concerning a plurality of third party websites, when the first website is activated with respect to the internet (see column 5, line 24 – column 6, line 20).

As per claim 6, Wexler teaches:

The method of claim 4, further comprising:

when the element for marketing the first website is a link to the first website, causing the display at the reciprocal site of the first website of a plurality of links to the plurality of third party websites, when the first website is activated with respect to the Internet (see column 5, line 24 – column 6, line 20).

Claim 19 contains the same limitations as claim 1 therefore the same rejection is applied.

Claims 13-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hess et al (U.S. 6,058,417).

As per claim 13, Hess et al teach:

A method of assisting a website designer in establishing an e-commerce feature on a first website being designed by the website designer for access by third parties upon the activation of the first website on the Internet, the method comprising:

receiving at a user interface a selection of the e-commerce feature that is desired to be implemented on the first website, wherein the e-commerce feature is at least one of a shopping cart and an auction (see figures 6A-B,9A);

receiving at the user interface information concerning a picture of a product desired to be sold using the e-commerce feature (see figure 6B);

receiving at the user interface information concerning a written description of the product (see figure 6B);

receiving at the user interface information concerning a price of the product (see figure 6B);

receiving at the user interface information concerning an identification number of the product (see column 7, lines 24-31); and

when the first website is activated on the Internet, displaying the e-commerce feature on the first website, wherein display of the e-commerce feature includes the display of at least some of the picture, written description, price and identification information of the product (see figure 9A).

As per claim 14, Hess et al teach:

The method of claim 13, further comprising, prior to receiving at the user interface the selection of the e-commerce feature that is desired to be implemented:

displaying a list of at least one of a plurality of shopping carts and a plurality of auctions (see figure 6A).

As per claim 15, Hess et al teach:

The method of claim 13, wherein the e-commerce feature that is selected is an auction, and the information concerning the price of the product concerns a reserve price (see figure 6B).

As per claim 16, Hess et al teach:

The method of claim 13, wherein the information concerning the picture of the product is uploaded from a memory device at a website designer computer, and

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wherein the information concerning the written description, price and identification number of the product is received at the user interface into a form field (see figure 6B).

As per claim 17, Hess et al teach:

The method of claim 13, further comprising, after the receiving of the information concerning the identification number of the product:

prompting for an input of a merchant account identifier (see column 7, lines 15-20);

when the merchant account identifier is received, saving the information concerning the selected e-commerce feature, the received information concerning the picture, written description, price and identification number of the product, and the merchant account identifier (see column 7, lines 15-32);

when an indication that no merchant account identifier exists is received, providing a merchant account information form, receiving merchant account information at the user interface, and sending the merchant account information to a merchant account vendor, wherein, the e-commerce feature is only displayed on the internet when both the first website is activated on the internet and the merchant account identifier has been received (see column 7, lines 15-40).

As per claim 18, Hess et al teach:

The method of claim 13, further comprising:

providing a first display region on the user interface, the first display region being capable of displaying a plurality of elements (see figure 6B);

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displaying the selected e-commerce feature including at least some of the information concerning the picture, written description, price and identification number of the product on the first display region, wherein the first display region is capable of displaying the e-commerce feature in an interactive manner (see figure 6B, 9A).

Claim 20 contains the same limitations as claim 13 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (U.S. 5,960,409) in view of Underwood et al (U.S. 6,601,057).

As per claim 7, Wexler fails to teach:

The method of claim 1, wherein the element for marketing is the banner ad concerning the first website, further comprising:

determining whether the banner ad for the first website has already been designed; and when it is determined that the banner ad for the first website has not yet been designed, displaying a message at the user interface indicating the necessity of designing the banner ad. However, Underwood teaches a system that modifies and creates web sites and insert and edit advertisements (see figures 25-27; column 52, lines 23-30). Therefore, it would have been obvious to a person of ordinary skill in the

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art at the time the application was made, to know that Wexler would use the Underwood system to create and edit banner advertisements, and when it is determined that the banner ad for the first website has not yet been designed, displaying a message at the user interface indicating the necessity of designing the banner ad. There would be no purpose in creating a website if nobody knows that it exists.

As per claim 8, Wexler fails to teach:

The method of claim 7, further comprising, when it is determined that the banner ad for the first website has not yet been designed:

providing a first display region on the user interface, the first display region being capable of displaying a plurality of elements;

receiving a search request for available banner ad designs at the user interface;

performing a search of information concerning a plurality of available elements stored on a second database in response to the search request, wherein a search engine program performs the search;

displaying results of the search on the user interface; and

receiving a selection command at the user interface to select a first banner ad design from the results.

However, Underwood teaches:

providing a first display region on the user interface, the first display region being capable of displaying a plurality of elements (see figure 14);

receiving a search request for available banner ad designs at the user interface (see figures 24-26);

performing a search of information concerning a plurality of available elements stored on a second database in response to the search request, wherein a search engine program performs the search (see figures 24-26);

displaying results of the search on the user interface (see figures 24-26); and

receiving a selection command at the user interface to select a first banner ad design from the results (see figure 25).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would use the Underwood system to create and edit banner advertisements. There would be no purpose in creating a website if nobody knows that it exists.

As per claim 9, Wexler fails to teach:

The method of claim 8, further comprising:

providing a second display region on the user interface, the second display region being capable of displaying the plurality of elements;

displaying the first banner ad design in the second display region;

receiving a first command to modify the first banner ad design in the second display region;

modifying the first banner ad design in response to the first command;

terminating the display of the second display region;

displaying the modified first banner ad design in the first display region, wherein the first display region is capable of displaying the first banner ad design in an interactive manner; and saving the modified first banner ad design.

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However, Underwood teaches that one of the current trends in web site development products is the ability to drag objects and position them anywhere on the screen (see column 2, lines 38-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would use the Underwood system to design banners ads and that it would use the whole computer display to edit the banners and see how banners would be arranged, as taught by Underwood. This feature would give users a dynamic display where the users can edit and update their images or banners and would make it easier for the website designer to edit and create the advertisements.

As per claim 10, Wexler fails to teach:

The method of claim 9, further comprising:

receiving at the user interface a command to preview the modified first banner ad design; and

providing a preview of the modified first banner ad design, wherein the preview allows for the display of all visual effects of the modified first banner ad design, and allows for the sounding of all sonic effects of the modified first banner ad design.

However, Underwood teaches about a system that allows the user to see previews of the website element created and also includes audio or audio video (see figure 61, item 6125 and column 9, lines 11-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would use the Underwood system to preview the banners advertisements created and would also preview the elements if they contain audio or video. This feature

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would allow the web designer to determine how the banner ads would look when they are published over the Internet.

As per claim 11, Wexler fails to teach:

The method of claim 9, further comprising, prior to the saving of information concerning the modified first banner ad design:

displaying a prompt concerning payment;

receiving credit card processing information at the user interface; and determining the adequacy of the credit card processing information.

However, Underwood teaches a system that modifies and creates web sites with credit card processing (see column 52, lines 23-67; column 55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would include credit card processing, as taught by Underwood, to be able to charge customers for the use of his system. This feature would simplify the payment process by eliminating the need to mail checks for payments.

As per claim 12, Wexler fail to teach:

The method of claim 1, further comprising, prior to receiving the information indicating the type of the element and the information specifying the second website:

providing a first display region on the user interface, the first display region being capable of displaying a plurality of elements;

receiving a selection of the smart agent option at the user interface, the selection of which is indicative of a desire to establish the arrangement between the first website

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being designed by the website designer and the second website in order to market the first website at the second website upon the activation of the first website on the internet;

displaying a smart agent menu having a suggested marketing locations option, a create links option and a banner ad rotations option, wherein the create links option and the banner ad rotations option can be selected to indicate the type of the element for marketing.

Wexler analyzes the number of clicks on the banner, the percentage of clicks that result from the banner being displayed in a particular banner publisher's Web page and other statistics to determine which banner should be advertise in the corresponding publisher. Underwood teaches a system that edits and creates the elements of a website (see column 5, lines 38-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would use the Underwood system to create banners advertisements and would use his statistic system to determine the success of the advertisements. This feature would help the advertisers to determine if the money spent in ads is producing good results or not.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (U.S. 5,960,409).

As per claim 21, Wexler teaches:

An internet-based system for assisting a website designer in establishing an arrangement between a first website being designed by the website designer and a

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second website in order to market the first website at the second website upon the activation of the first website on the Internet, the system including:

receives at a user interface displayed at one of the registered user computers information indicating a type of an element for marketing that is to be displayed at the second website, and information specifying the second website at which the element is to be displayed (see column 3, lines 35-45);

saves the information at a first database that is coupled to the server computer (see column 4, lines 27-35);

obtains an element for marketing (see column 4, lines 37-40);

hosts the second website (see column 5, lines 55-60);

activates the first website on the Internet by hosting the first website on the Internet (see column 5, lines 24-30);

provides a web page of the second website to one of the unregistered computers (see column 4, lines 28-36); and

displays the element for marketing on the web page (see column 4, lines 28-36).

Wexler does not expressly teach a server computer accessible by a plurality of registered user computers and a plurality of unregistered computers using the Internet. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that in order for an advertiser to publish banners advertisements in the publisher website, it would obviously make good business sense to ask that the advertisers register so the publisher can charged a fee for publishing

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their ads (see column 2, lines 10-14). The fee charged would be the revenue that would allow the publisher to maintain a web presence in the Internet.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.L.

Daniel Lastra
October 17, 2003


MICHAEL A. KEMMER
EXAMINER